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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,612	03/29/2004	Robert E. Carlson	14095.5/US/1	4342
23552 7590 03/22/2010 MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				
EXAMINER				
LUNDGREN, JEFFREY S				
ART UNIT		PAPER NUMBER		
1639				
MAIL DATE		DELIVERY MODE		
03/22/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/813,612

Applicant(s)

CARLSON, ROBERT E.

Examiner

JEFFREY S. LUNDGREN

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8, 9, 67-76, 79-85 and 88-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 9, 67-76, 79-85 and 88-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/8/10
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

Claims 1-4, 8, 9, 67-76, 79-85 and 88-91 are pending in the instant application, and are the subject of the Office Action below.

Previous Grounds of Rejection Withdrawn

The previous grounds of rejection raised in the Office Action mailed on July 8, 2009, is withdrawn in view of Applicants' amendments to the claims.

Claim Rejections - 35 USC § 102(e)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

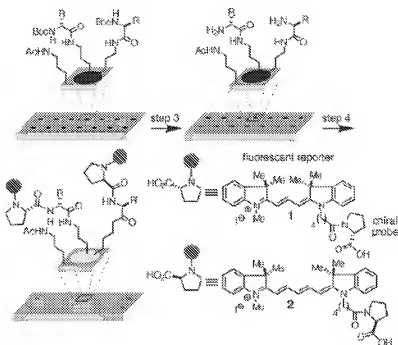
Claims 1-4, 8, 9, 67-76, 79-85 and 88-91 are anticipated by Shair:

Claim 1-4, 8, 9, 67-76, 79-85 and 88-91, are rejected under 35 U.S.C. § 102(e) as being unpatentable over Shair *et al.*, U.S. Patent Appl. Publication No. 2002/0090728, published on July 11, 2002.

Applicants' claimed invention is directed towards a method of making an array, the array comprising a plurality of array elements, each array element comprising a unique binary mixture of at least two building blocks (e.g., array element 1 [A,B]; array element 2 [A,C]; ...array element n [X,Y]). Each of the building blocks comprises a framework and at least one recognition element, and has the amended limitation that excludes building blocks with more than a single amino acid derivative. The building blocks read on single amino acid residues

derivatized with a large range of organic scaffolds, and therefore each array element reads on a mixture or amino acid residues with different organic scaffolds, or different recognition elements.

Shair is directed towards the use of an array of organic compounds formed from various mixtures. The array of Shair comprises multiple array elements, each array element comprising two distinct compounds, each compound comprising a different amino acid (D-form and L-form amino acids), and also comprising a different organic recognition element (e.g., Cy3 and Cy5). Shair illustrates this concept in Figure 4:



In this figure, there is shown a plurality of array elements, and a blow-out of a single array element comprising two distinct compounds. Of the two distinct compounds, Shair teaches amino acid derivatives which are encompassed by the claimed framework, and the attached fluorophores (e.g., the claimed substituted alkyl, cycloalkyl, heterocycle, etc.) and/or the amino acid side chains that fall with the claimed recognition elements (e.g., alkyl and aryl, either of which may be substituted – see the proline, serine and phenylalanine in Figures 12 and 14).

As in the claims, Shair shows that any of the array elements could be considered the lead artificial receptor, and show varying the ee ratios to obtain the fastest/tightest binders (see Figures 12 and 14, and description thereof), and there are multiple sets and subsets of building blocks. See also Figure 5, wherein this instant the Cy3 and Cy5 dyes could be considered the ligand for binding.

As in, the amino acid side chains (e.g., the proline ring feature, the leucine alkyl chain, the phenylalanine) and the various Cy3 or Cy5 dyes, meet the limitations of the two recognition elements for the first and second building blocks, and the framework of the building blocks, and is shown to be attached with various linker molecules, including alkylcarbonyl groups (Shair, paragraph 0014). Accordingly, the claims are anticipated.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 8, 9, 67-76, 79-85 and 88-91 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of each of U.S. Patent Nos. 7,504,364 and 7,504,365. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to essentially the same subject matter, wherein any of the claimed differences are obvious over each other.

Conclusions

No claim is allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

If Applicants should amend the claims, a complete and responsive reply will clearly identify where support can be found in the disclosure for each amendment. Applicants should point to the page and line numbers of the application corresponding to each amendment, and provide any statements that might help to identify support for the claimed invention (*e.g.*, if the amendment is not supported *in ipsi verbis*, clarification on the record may be helpful). Should

Applicants present new claims, Applicants should clearly identify where support can be found in the disclosure.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeff Lundgren whose telephone number is 571-272-5541. The Examiner can normally be reached from 7:00 AM to 5:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christopher Low, can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffrey S. Lundgren/

Primary Examiner, Art Unit 1639